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09/802,760	03/08/2001	Paul Gloyer	10113	8217

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12/03/2003

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EXAMINER

GORR, RACHEL F

ART UNIT

PAPER NUMBER

1711

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 1125

Application Number: 09/802,760
Filing Date: March 08, 2001
Appellant(s): GLOYER ET AL.

MAILED

DEC 02 2003

GROUP 1700

Roger P. Glass
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 27, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3-10, 25-33 and 47 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,286,570	SCHLUETER	02-1994
4,729,925	CHEN	03-1988
0,604,334	RAMOS (Europe)	06-1994

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-10, 25-33 and 47 are rejected under 35 U.S.C. 103 (a) as being obvious over Schlueter in view of Chen and Ramos.

Schlueter discloses polyurethanes (example II) made from 50 wt. % prepolymer, 38 wt. % polyether polyol and 25 wt. % hardener comprising a polyol and less than 2 wt. % of a charge control agent, and made at an NCO/OH ratio of 0.96 and having a resistivity value of 3×10^9 . Schlueter differs from the claims by not showing a charge control agent that becomes chemically incorporated into the polyurethane molecule.

Chen discloses the charge control agents of the claims (example 10 shows the structure of appellant's claims 4 and 28). He teaches that a charge control agent that is chemically incorporated into the polyurethane will retain its level of resistivity (bottom col. 1). He discloses that the polyurethane can comprise 0.04-0.01 mole % of the charge control agent (bottom col. 1). His polyurethane is made from a prepolymer and a hardener comprising a blend of a polyether polyol (col. 5, line 31) and another polyol as well as the charge control agent.

Ramos shows polyurethanes comprising the preferred charge control agent of Chen's example 10 (see abstract and example) and of appellant's claims 4 and 28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the charge control agents of Chen and Ramos in the polyurethane of Schlueter's formulation to prevent the charge control agent from leaching out. It would have been obvious to vary the amount of charge control agent in order to vary the resistivity value.

(11) Response to Argument

The appellant argues that, according to their new calculation, Schlueter doesn't use the specified amount of prepolymer in example II because Schlueter's prepolymer comprises too much diisocyanate. The appellant's claims read on the same prepolymer composition of Schlueter. The appellant's claims don't specify how their prepolymer is made, what NCO content it has, or what is its molecular or equivalent weight.

The appellant argues that one wouldn't be motivated to change the charge control agent of Schlueter because Schlueter teaches that crosslinking prevents his charge control agent from leaching out. One of skill in the art can see that the charge control agents of Chen and Ramos will not migrate out of the polymer at all because it's incorporated in the backbone. All three references crosslink, probably to provide the needed properties of hardness, etc.

The appellant further argues that because the polyurethane of Ramos is softer, one wouldn't combine Ramos and Schlueter. The polyurethane compositions and properties of all three references are similar except that Ramos adds a plasticizer to make his polyurethane softer.

For the above reasons, it is believed that the rejections should be sustained.

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Art Unit: 1711

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Respectfully submitted,

R.G.
November 25, 2003

Conferees

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